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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,315	09/22/2000	Jan Kall	781-377USW1	1322

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EXAMINER

TRINH, SONNY

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 02/17/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668,315

Applicant(s)

KALL, JAN

Examiner

Sonny TRINH

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 is/are allowed.
- 6) ☒ Claim(s) 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2(09/22/00).
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 16-17** are rejected under 35 U.S.C. 102(e) as being anticipated by Shaheen et al. ("Shaheen"; U.S. Patent Number 6,128,490).

Regarding **claim 16**, Shaheen discloses a base transceiver station (BTS) comprising channels for at least one cell, one of the cells being a cell-specific broadcast channel for transmitting general information to the mobile stations in the cell, c h a r a c t e r i z e d by the base transceiver station (BTS) being arranged to transmit at least one service-on-demand over one of its channels, the service-on-demand being available to all mobile stations located in the cell (abstract, column 2 line 66 to column 4 line 32, column 6 lines 1-23, column 7 line 61 to column 8 line 24).

Regarding **claim 17**, Shaheen further teaches that the base transceiver station (BTS) being arranged to transmit in the general information of the cell a notification of the services-on-demand available at the cell (column 8 line 9-24).

Allowable Subject Matter

2. **Claims 1-15** are allowed.

The following is an examiner's statement of reasons for allowance:

The present invention relates to the method and apparatus for implementing the method for using and implementing a service-on-demand in a mobile communication system. The service-on-demand are intended to be received by means of a mobile station. The mobile station monitors of a cell transmission and receives parts intended for the mobile station from the transmission. In order to use the services-on-demand, in the method the service-on-demand is offered in the cell to all mobile stations located in the cell over a first channel, a registration message is transmitted from the mobile station for registering as a user of the service-on-demand over a signaling channel, an acknowledgement (2-4) of the registration, indicating how the service-on-demand is received, is received at the mobile station, and the reception of the service-on-demand is started over the first channel in a manner indicated by the registration acknowledgement.

The closest prior art, Jackson (US 6,516,466) shows a portable entertainment system using digital cellular technology that allows a user to retrieve and play a vast array of musical (music on demand) without the need to carry a large quantity of compact discs or similar media.

However, Jackson fails to show the steps of "... offering in the cell the service-on-demand to all mobile stations located in the cell over a first channel, transmitting

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from the mobile station a registration message for registering as a user of -the service-on-demand over a signaling channel, receiving at the mobile station an acknowledgement of the registration, which indicates how the service-on-demand is received, and starting to receive the service-on-demand over the first channel in a manner indicated by said acknowledgement message...".

This distinct feature has been added to independent claim 1 and renders it allowable.

Regarding **claim 5**, Jackson also fails to show that at least one mobile station (MS) being arranged to register as a user of the service-on-demand by transmitting a registration message over a signaling channel, to receive an acknowledgement of the registration and to start receiving the service-on-demand over the first channel of the location cell in a manner indicated by the information included in the acknowledgement, and to convey the service-on-demand to the user.

Regarding **claim 9**, Jackson also fails to show the registration means for composing and transmitting a registration message to the mobile communication network over a signaling channel, the registration message indicating that the user of the mobile station desires to register as a user of the service-on-demand available at the location cell, and for receiving an acknowledgement of the registration, and service means (CP) responsive to the acknowledgement for receiving the service-on-demand in a manner indicated by the acknowledgement, and for conveying the service to the user interface.

Regarding **claim 13**, Jackson also fails to show the service means (SP) for offering at least one service-on-demand to a service area which comprises at least one mobile communication system cell, registration means (RP) for receiving and acknowledging the registration of a user of the service-on-demand, and billing means (BP) responsive to the registration means for charging the user for the use of the service-on-demand.

Claims 2-4, 6-8, 10-12 and 24-15 are allowed by virtue of their dependencies on claims 1, 5, 9, 11, and 13 respectively.

Citation of Pertinent Prior Art

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Inventor	Publication	Number	Disclosure
Schulhof et al.	US Patent	5,557,541	Apparatus for distributing subscription and on demand audio programming.
Cesar et al.	US Patent	6,591,422	Facility for assigning transmission channels to terminals of a service on demand.
Salmela et al.	US Patent	6,516,193	Localized special services in a mobile communication system.

Conclusion

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks
Washington, D.C. 20231*

or faxed to:

(703) 872-9306, (for formal communications intended for entry, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, 6th Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny Trinh whose telephone number is (703) 305-1961. The examiner can normally be reached Monday through Thursdays from 7:00 am to 4:00 p.m., and on alternate Fridays.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.

Sonny Trinh

Patent Examiner
2/12/04



**SONNY TRINH
PATENT EXAMINER**